REMARKS/ARGUMENTS

The Office Action dated October 15, 2003 has been received and carefully studied.

The Examiner rejects claims 1-3,7-9 and 11-20 under 35 U.S.C. §103(a) as being unpatentable over prior U.S. Patent No. 5,558,006 (Kuboyama) in combination with U.S. Patent No. 4,045,586 (Howland et al.) in further combination with U.S. Patent No. 5,114,722 (Zoubek).

The '586 patent recites a method of mixing the condensate solution with an aqueous solution of a fixative and drying (Column 3, lines 5-7). The patent further recites the properties of the fixative. Among other listed characteristics, the fixative must be water-soluble and "necessarily be edible, compatible with coffee formulations, and should not impact any undesirable off-tastes" (Col 3, lines 50-61). The patent lists several suitable fixatives meeting the above-mentioned characteristics. These are described as being bland water soluble carbohydrates, such as dextrins, corn syrup, dextrose, lactose and the like (Col 3, lines 62-65).

The Examiner correctly notes that the '586 does not teach that the fixative or absorbent material is polyvinylidene fluoride or glass fibers.

The Examiner notes that the '722 patent teaches that polyvinylidene fluoride and glass fiber filters are known

materials in the art of filtration and extraction. The Examiner further states that it would have been obvious to a person of ordinary skill in the art to use the materials of Zoubek in the methods of Kuboyama and Howland. The Examiner also states that one of ordinary skill in the art would have been motivated to do this to isolate the extract and form a dry solid of the extract.

These statements, and the accompanying rejection, are respectfully traversed.

As stated in MPEP §2143.01, even when the combination of references teaches every element of the claimed invention, without a motivation to combine, a rejection based on a prima facie case of obviousness is improper. In re Rouffet, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The court held in Rouffet that the obviousness claim was improper since the Board relied only on the high level of skill in the art to provide motivation. There have been numerous other instances where the court has reversed rejections due to lack of motivation. MPEP 2143.01 also explains In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), where the claims were directed to a system of detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. In the Fine case, the prior art reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means and

a detector. Id at 1598. The secondary reference taught a nitric oxide detector. Id. While the examiner and the Board stated that it would have been within the skill of the art to substitute one type of detector for another, the Court found that the Board erred in reaching this conclusion and reversed. The court stated that Eads, the primary reference, "instead of suggesting that the system could be used to detect nitrogen compounds, … deliberately seeks to avoid them; it warns against rather than teaches Fine's invention". Id. at 1599.

Returning to the present rejection, the '586 patent specifically teaches that the fixative MUST possess certain physical and chemical qualities. It must be water-soluble, it must be edible, and it should not impart any undesirable off-tastes:

> "In light of the above considerations, then, the fixative must possess certain physical and chemical qualities. **It must be water soluble** and must not contain the complementary non-volatile components present in the stripped extract which react with the volatiles to form off-flavors. Further, since alteration of the volatiles even to non-reactive stable components is undesirable, the fixative must be one that is inert to these volatile constituents which are to be protected. Also, since the fixative remains in the coffee product, **it must necessarily be edible, compatible with coffee formulations, and should not impart any undesirable off-tastes."** (Emphasis added.)

(Column 3, lines 50-61). Accordingly, regardless of the teachings of the secondary references, one skilled in the art would not be motivated to substitute a water-insoluble,

non-edible fixative for the fixative of the '586 patent. Similar to the Eads patent in the In re Fine case, the '586 patent teaches away from doing so. There is nothing in the Zoubek and Howland references that suggests the desirability of making the combination relied upon by the Examiner. Indeed, were the substitution of polyvinylidene fluoride or glass fibers made, the Howland invention would fail for its intended purpose. As stated in MPEP §2143.01, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Clearly, substituting a non-edible absorbent, such as polyvinylidene fluoride and glass fiber filters, for the edible fixative of the '586 reference to capture coffee extract and then combining them with coffee powder, would render the invention of Howland unusable for its intended purpose. Simply put, it would no longer be edible.

Accordingly, Applicant respectfully submits that the combination of references relied upon in making the rejection is improper.

The Examiner rejects claim 10 as being unpatentable in view of the '006 patent in combination with the '586 patent and the '722 patent, in further combination with U.S. Patent 4,506,510 (Tircot). The '510 patent teaches a condensing chamber in which one or more thermoelectric coolers are contained that further comprise a heat sink. This rejection is respectfully traversed. Since claim 10

depends from claim 1, the arguments set forth above apply equally to the rejection.

Reconsideration and allowance are respectfully requested in view of the foregoing remarks.

Respectfully submitted,

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